

Application No. 08/41,459  
Response dated January 22, 2004  
Reply to Office Action of October 27, 2003

**REMARKS/ARGUMENTS**

Claims 4-6, 13-16, and 23-35 are pending in the application; the status of the claims is as follows:

Claims 23-26 are allowed.

Claims 4-6, 13-16, 27-31, 33, and 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,383,754 to Sumida, et al. ("Sumida").

Claims 32 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sumida in view of U.S. Patent No. 5,930,006 (cited in the Office Action dated 12/17/02) to Yoshida, et al. ("Yoshida").

**35 U.S.C. § 102(b) Rejection**

The rejection of claims 4-6, 13-16, 27-31, 33, and 35 under 35 U.S.C. § 102(b) as being anticipated by Sumida, is respectfully traversed based on the following.

Claim 4 includes the limitation of a selection inhibiting controller that automatically prohibits selecting an inoperable mode via an operation panel. In contrast, Sumida does not automatically prohibit selecting an inoperable mode via an operation panel. Sumida does disclose automatically prohibiting operation of a previously selected inoperable mode. The Office Action indicates col 31, line 14 through col 32, line 26 discloses automatically prohibiting selection of an inoperable mode. In fact, at col 32, ll 15-19 notes "the program interrupts the copying operation," i.e., it prohibits operation of the inoperable mode, not selection of the inoperable mode. The Office Action also indicates col 80, line 6 through col 81, line 6 and col 81, line 56 through col 82, line 3 similarly disclose prohibiting selection of an inoperable mode. In fact, col 80, ll 17-22 provide four options: interrupting copying, inhibiting stapling, rotating an image, or scanning an image in a reverse direction. None of these four options discloses prohibiting

selection of an inoperable mode, each relates to prohibiting an operation or changing an operation. Column 81, ll 65 and 66 disclose only two options: displaying a warning or inhibiting stapling. Therefore, as claim 4 requires prohibiting selection of an inoperable mode, not merely prohibiting operation of an inoperable mode, Sumida cannot anticipate claim 4.

Claims 5, 6, and 27 depend from claim 4. As claim 4 is unanticipated by Sumida, claims 5, 6, and 27 are similarly unanticipated by Sumida for at least the same reasons.

Claim 13, like claim 4, includes the limitation of a selection prohibiting controller that automatically prohibits selection of an inoperable mode via an operation panel. As discussed above, Sumida does not disclose prohibiting selection of an inoperable mode, but merely prohibiting operation of a previously selected inoperable mode. Thus, claim 13 is unanticipated by Sumida for at least the same reasons as claim 4. Claims 14-16 depend from unanticipated claim 13 and are unanticipated by Sumida for at least the same reasons.

Claim 28 includes the limitation of an operation panel that automatically prohibits selecting an inoperable mode. As discussed above, Sumida does not disclose prohibiting selection of an inoperable mode, but merely prohibiting operation of a previously selected inoperable mode. Thus, claim 28 is unanticipated by Sumida for at least the same reasons as claim 4. Claims 29 and 30 depend from unanticipated claim 28 and are unanticipated by Sumida for at least the same reasons.

Claim 31 includes the limitation of means for editing pixel density data from said pixel density data stored in a memory. The Office Action indicates col 19, ll 38-49 of Sumida disclose such a means for pixel editing. This is far from clear. Column 19, ll 38-49 disclose a compressor and an expander such that compressed data may be written to the memory. Given this description, it appears that the compressor and expander are merely a way to save space in a memory. In other words, the pixel density data that enters the compressor would be the same as the pixel density data that comes out of the expander. Unless and until actual editing of pixel density data is disclosed, e.g., a portion of the

image is deleted or the contrast/color of the image is altered, Applicant asserts that Sumida does not disclose means for editing pixel density data.

Claim 31 includes the limitation of a feeder capable of feeding different size originals. The Office Action indicates col 15, ll 9-24 of Sumida disclose a feeder capable of feeding different size originals. In fact, col 15, ll 9-24 disclose only a feeder, but does not specify whether the feeder can feed originals of different sizes.

Claim 31 includes the limitation of means for reading mixed originals. The Office Action indicates col 17, ll 2-60 of Sumida disclose a means for reading mixed originals. In fact, col 17, ll 2-60 disclose a means for reading an original, but does not specify whether the means can read mixed originals.

Claim 31 further includes means for determining a size of an image. The Office Action indicates col 43, line 51 through col 46, line 36 of Sumida disclose a means for determining a size of an image. In fact, col 43, line 51 through col 46, line 36 disclose identifying the orientation of an image. This is clear as col 43, l 51 indicates the section that follows addresses “Identification Based on Layout of Entire Image” and the following line begins “For the simple identification of an orientation.” Column 45, ll 1 and 2 begin “[a] method of identifying the orientation of a document image will be described.” While the indicated section of the Sumida patent includes terms such as Xmin and Xmax, a careful reading shows these indices are used to determine the orientation of an image, not its size.

Lastly, Claim 31 includes the limitation of means for controlling which permits editing of an image when the originals are uniform in size and prohibits editing when the originals are not uniform in size. The Office Action indicates col 39, l 43 through col 40, l 62 of Sumida discloses means that permits editing of an image when the originals are uniform in size. In fact, the indicated section relates solely to binding a document, not editing an image. Clearly, binding a document is not the same as editing an image. The Office Action indicates col 47, line 53 through col 50, line 15 similarly disclose means for

editing an image when the originals are uniform in size. This indicated section relates to the orientation of an image, not its size and thus is not relevant. Lastly, the Office Action indicates col 74, ll 14-64 discloses means for editing an image when the originals are uniform in size. Like the previous section, this section of Sumida relates to the orientation of an image, not its size and thus is likewise irrelevant to claim 31. The Office Action indicates col 30, line 33 through col 31, line 26 discloses a means that prohibits editing an image when the originals are not uniform in size. Once again, the indicated section discusses the orientation of the image, not the size of the image. In any case, this section does not prohibit editing an image, it merely displays a warning as stated at col 31, ll 19-22. Lastly, the Office Action indicates col 74, ll 14-64 discloses a means that prohibits editing an image when the originals are not uniform in size. As noted above, this section of Sumida relates only to the orientation of an image, not its size and thus is not relevant.

In sum, Sumida fails to disclose means for editing pixel density data, a feeder capable of feeding different size originals, means for reading mixed originals, means for determining the size of an image, and means for controlling that permits editing of an image when the originals are uniform in size and prohibits editing an image when the originals are not uniform in size. Because Sumida fails to disclose at least these limitations of claim 31, Sumida cannot anticipate claim 31.

Claim 33 includes a number of limitations in common with claim 31. In particular, claim 33 includes a feeder for different size originals, means for reading mixed originals, and means for determining a size of an image. As discussed above, Sumida does not disclose any of these elements. Claim 33 further includes means for controlling that permits stapling when images are uniform in size and prohibits stapling when the images are not uniform in size. While Sumida does disclose inhibiting stapling, it is based upon the orientation of the images. As Sumida does not determine the size of an image, it cannot disclose a means for controlling a stapler based upon the uniformity of the size of the image. Because Sumida fails to disclose each of these limitations, Sumida cannot anticipate claim 33.

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Claim 35, similar to claim 33, includes a controller that permits a stapler to operate when the sizes of the images are uniform and prohibits stapling when the sizes of the images are not uniform. As Sumida does not disclose determining the size of an image, only its orientation, Sumida cannot anticipate claim 35.

Accordingly, it is respectfully requested that the rejection of claims 4-6, 13-16, 27-31, 33, and 35 under 35 U.S.C. § 102(b) as being anticipated by Sumida, be reconsidered and withdrawn.

#### **35 U.S.C. § 103(a) Rejection**

The rejection of claims 32 and 34 under 35 U.S.C. § 103(a), as being unpatentable over Sumida in view of Yoshida, is respectfully traversed based on the following.

Claim 32 depends from unanticipated claim 31 and thus cannot be anticipated by Sumida. Further, Yoshida does not disclose or suggest each of the missing limitations. Yoshida discloses means for determining the size of the sheet of paper, but fails to disclose or suggest means for determining the size of an image. Without means for determining the size of the image, Yoshida cannot disclose or suggest control means for permitting or prohibiting editing of images based upon the uniformity of sizes of the images. Thus, the combination of Sumida and Yoshida fails to render obvious claim 31. As claim 32 depends from nonobvious claim 31, claim 32 is nonobvious for at least the same reasons.

Claim 34, similar to claims 31 and 32, includes the limitation of means for controlling that permits or prohibits editing of images based upon uniformity of image size. As above, the combination of Sumida and Yoshida fails to disclose or suggest means for controlling that permit or prohibit editing based upon uniformity of image size. Thus, the combination of Sumida and Yoshida cannot render obvious claim 34.

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Accordingly, it is respectfully requested that the rejection of claims 32 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Sumida in view of Yoshida, be reconsidered and withdrawn.

**CONCLUSION**

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

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Respectfully submitted,

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